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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,873	12/30/2004	Walter Stieglbauer	STIEGLBAUER ET AL - 1 PCT	7849
25889	7590	02/21/2008	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			KERNs, KEVIN P	
ART UNIT	PAPER NUMBER			
	1793			
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02/21/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,873	<b>Applicant(s)</b> STIEGLBAUER ET AL.
	<b>Examiner</b> Kevin P. Kerns	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 January 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,7 and 9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4,7 and 9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 December 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okita et al. (US 5,552,573).

Okita et al. disclose a resistance welding process and apparatus for welding of aluminum and aluminum alloy workpieces (e.g. metal sheets), in which the apparatus includes an insert material 9 provided over the electrode 1 and between the electrode 1 and the workpieces (11,12) as holding means for the insert material 9 (strip), such that the insert material 9 has a sheet-like core material 9a made of iron, steel, copper, or

copper alloy (having melting temperatures above 1000°C), and congruently arranged coated strip layers (9b,9c) made of Ni, Ni alloy, Ti, Ti alloy, Nb, Nb alloy, Mo, Mo alloy, W, W alloy, Cr, Cr alloy, Co, and Co alloy (having melting temperatures above 1000°C) that face the electrode 1 and workpieces (11,12), such that the superimposed strips (9a,9b,9c) would be exclusively positively connected via metallic (diffusion) bonding (e.g. plating, clad welding etc.) between the two metals, while the strips are able to be displaceably held via holding means at different speeds relative to each other via reels (22,23,24,25) – (i.e. means for driving and holding the strip -- see Figure 5; and column 10, lines 43-51), with little or no adhesion of the strips to the electrode and workpieces during resistance welding (abstract; column 3, lines 24-58; column 4, lines 32-48; column 7, lines 1-26; 1<sup>st</sup> paragraphs of Examples 1-13; and Figures 1, 2, 5, and 6). Although Okita et al. do not specifically disclose that the connections of the metal strips are by rabbeting or stamping, one of ordinary skill in the art would have recognized that these types of connections are similar in establishing a similar result as the clad welding process disclosed by Okita et al., as all three of these types of connections result in establishing a “bond” or “joining interface” between the two metal strips, thus suggesting the limitation “exclusively positively connected” of independent claim 1. Furthermore, one of ordinary skill in the art would have found it to have been “obvious to try” these various types of connections, since the applicants are choosing from a finite number of identified predictable solutions with a reasonable expectation of success, in order to establish the predictable result of obtaining a joining interface between the metal strips.

*KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ.2d 1385 (S.Ct. 2007).

***Response to Arguments***

4. The examiner acknowledges the applicants' amendment received by the USPTO on January 25, 2008. The amendment overcomes the prior objection to claim 9.

Claims 1-4, 7, and 9 remain under consideration in the application.

5. Applicants' arguments filed January 25, 2008 have been fully considered but they are not persuasive.

With regard to the applicants' remarks/arguments on pages 4-10 of the amendment, it is noted that the applicants' major arguments are that the metal strips of Okita et al. allegedly are not "superimposed strips" that are "displaceable relative to each other", and that it would not be "obvious to try" to use other connecting methods rather than the claimed "rabbeting or stamping". The examiner respectfully disagrees with these arguments. First, and contrary to the applicants' arguments in the last two paragraphs on page 6 of the remarks/arguments section, the insert material 9 of Okita et al. would be considered as a "strip" under the broadest reasonable interpretation of the claim, as this material 9 (which the applicants insist is a "coating" and not a "strip") is attached to a sheet-like core material 9a (also see above section 3 of the 35 USC 103(a) rejections), which forms an "exclusively positively connected" bonded joint. Regarding the speeds "displaceable relative to each other", it is noted that the speed of material 9 and core material 9a would certainly have differing localized speeds adjacent to reels (22,23,24,25), as the material closer to the reel would be fed more quickly than

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the material further from the reel. In addition, and in further response to the arguments throughout pages 7 and 8 of the remarks/arguments section, it is noted that the applicants did not specifically claim that the "two superimposed metal strips (2,3)" would be compared with each other in terms of relative displacement, but with the other pair of metal strips (2,3) on the other pair of reels, as broadly interpreted in the absence of distinct claim language. Finally, the examiner respectfully disagrees with the applicants' argument that the claimed "rabbeting or stamping" limitation overcomes the 35 USC 103(a) rejections in view of Okita et al. under the "obvious to try" analysis that is rendered obvious under the KSR standards set forth above, as the predictable result of obtaining a joining interface between the metal strips would result. As a result, claims 1-4, 7, and 9 remain rejected.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571)272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin P. Kerns  
Primary Examiner  
Art Unit 1793

/Kevin P. Kerns/  
Primary Examiner, Art Unit 1793  
February 10, 2008